REMARKS

The Amendments

The new dependent claims are supported by the disclosure at page 3, line 36, to page 4, line 6; page 24, lines 23-36; and the Examples, particularly Examples 2, 5, 8, and 13.

The amendments do not narrow the scope of the claims and/or were not made for reasons related to patentability. The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application.

The Rejection Under 35 U.S.C. § 103

The rejection of claims 11-34 under 35 U.S.C. § 103, as being obvious over Kondo (U.S. Patent No. 6,210,761), the sole rejection herein, is respectfully traversed.

Together with the CPA filing on November 12, 2002, applicants filed a short Preliminary Response with some arguments. It would appear those arguments were not considered. Thus, applicants repeat those arguments here and expand upon them.

As stated in the Advisory Action, US '761 (Kondo) does disclose compounds in Composition Examples 3, 4, 8 and 9 which fall within formula II of current claim 11 (Composition Example 7 might also, but it is not clear what the E symbol stands for). In each of these Examples, however (in fact, each of Examples 1-10), such compounds are included only in mixtures which contain dielectrically negative and dielectrically neutral compounds. All of the compositions of Composition Examples 1-10 for which Kondo provides dielectric anisotropy data (i.e., no data provided for Composition Example 8) exhibit a negative overall dielectric anisotropy; see Examples 6-15 (also called Use Examples 3-12). Thus, these examples of Kondo are distinct from instant claim 11 for two reasons. First, they fail to contain a compound of applicants' formula II together in a mixture with a dielectrically positive compound of applicants' formula I or of any other dielectrically positive compound. Second, they fail to teach a composition which contains a compound of applicants' formula II

and, overall, exhibits a positive dielectric anisotropy. The compositions of Kondo which do contain dielectrically positive compounds and an overall positive dielectric anisotropy, i.e., Composition Examples 11-22, contain no compounds of applicants' formula II.

Applicants respectfully submit that a consideration of the Kondo disclosure as a whole does not fairly suggest to one of ordinary skill in the art a composition containing a compound meeting applicants' formula II and also containing compounds with positive dielectric anisotropy such that the composition overall has a positive dielectric anisotropy. Kondo provides a very broad generic teaching of compositions containing any of a number of broadly defined optional components, e.g., of broad general formulae (1) - (12). However, as was clearly set forth in In re Jones, 21 USPQ 2d 1941 (Fed. Cir. 1992), it is not the law that ".. regardless of how broad, a disclosure of a chemical genus renders obvious any species which happens to fall within it." Instead, the disclosure must be considered as a whole as to whether it fairly suggests the claimed invention to one of ordinary skill in the art. Although the disclosure is not limited by its Examples, the Examples must be considered in assessing what the disclosure as a whole fairly suggests. Kondo recites a number of separate embodiments of its invention and embodiments [8] and [9] discussed at col. 4, line 62, to col. 5, line 44, relate to compositions containing only dielectrically negative and dielectrically neutral compounds or only dielectrically negative compounds. Such compositions will, overall, obviously have a negative dielectric anisotropy and Kondo discloses the desirability of such result for certain applications; see, e.g., col. 1, lines 32-38. Other embodiments are desired for an overall dielectrically positive composition. When one of ordinary skill in the art looks at the Kondo disclosure for choosing which compounds to select for use to provide either a dielectrically negative or positive composition, the Examples unfailingly direct that compounds of applicants' formula II are only desired for use in an overall dielectrically negative composition and not together with dielectrically positive compounds also. Every composition example of Kondo which contains a compound of applicants' formula II

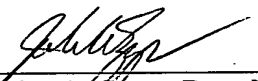
excludes compounds having positive dielectric anisotropy and, thus, provides a dielectrically negative composition. Conversely, every composition example of Kondo which includes dielectrically positive compounds and has an overall positive dielectric anisotropy, i.e., Examples 11-22, excludes any compound of applicants' formula II.

Accordingly, applicants urge that there is no fair suggestion from the Kondo disclosure of compositions containing dielectrically positive compounds in addition to compounds of formula II and exhibiting an overall positive dielectric anisotropy. Particularly in view of the direction provided by the Kondo examples, there would have been no suggestion to one of ordinary skill in the art to pick and choose from Kondo's broad disclosure compounds which would meet the component and property recitations of the instant claims. Thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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